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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/575,116

05/23/2000

Kia Silverbrook

NPA017US

9127

24011

7590

07/06/2004

SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

LAMB, TWYLER MARIE

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/575,116

Applicant(s)

SILVERBROOK ET AL.

Examiner

Twyler M. Lamb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

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## **DETAILED ACTION**

### **Notice to Applicant (s)**

1. This action is responsive to the following communications: amendment B filed on 4/26/04.
2. This application has been reconsidered. Claims 1-40 are pending.

### ***Withdrawal of Finality***

3. Due to the length of time it took for the Patent Office to match the amendment to the application, the finality of that action is withdrawn.

### ***Priority***

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright et al. (Wright) (US 5,426,594) in view of Cass (US 5,692,073).

With regard to claims 1 and 31, Wright discloses a method of selecting and delivering a greeting card (col 1, lines 6-11), including: obtaining a printed document with details of a selection of available greeting cards (col 4, lines 18-24; col 5, lines 51-

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57), the printed document having at least one user-interactive element with which a user interacts to select a card using a sensing device adapted to transmit interaction data to a computer system (col 4, line 17 – col 7, line 11); indicating selection of a card using the sensing device (col 6, lines 43-53); including a message using the sensing device (col 6, line 53 – col 7, line 5); and sending the card to a recipient address via the computer system (col 7, lines 6-11).

Wright does not teach using coded data thereon, at least some of the coded data representing at least one user-interactive element with which a user interacts to sense the coded data.

Cass discloses a process that includes using coded data thereon, at least some of the coded data representing at least one user-interactive element with which a user interacts to sense the coded data (col 2, lines 29-67; col 11, lines 15-26).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wright to include using coded data thereon, at least some of the coded data representing at least one user-interactive element with which a user interacts to sense the coded data as taught by Cass. It would have been obvious of one of ordinary skill in at the art at the time of the invention to have modified Wright by the teaching of Cass to specially coded information, such as a pattern of data glyphs or a bar code, can be included in the form itself to indicate the layout of the blank fields in the form. The computer can be programmed in this case to seek the coded information at a predesignated location within the received image, and to use the coded information together with additional (stored or preprogrammed) information to identify

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what kind of form has been sent and to determine what is to be done in response to the boxes checked by the user as taught by Cass col 2, lines 29-67.

With regard to claims 2, 17 and 32, Wright also discloses wherein the details are presented as a list of card categories and images of the greeting cards of each category are printed for viewing in a further document by selecting the respective category using the sensing device (col 4, lines 18-24; col 5, lines 10-22).

With regard to claims 3 and 18, Wright also discloses wherein the step of including a message comprises selecting a message from a list of messages (col 6, line 53 – col 7, line 5).

With regard to claims 4 and 19, Wright also discloses wherein the list of messages is provided in a further document which is printed after the card is selected, the further document having associated user-interactive elements for selection of the message (col 6, line 53 – col 7, line 5).

With regard to claims 5, 20 and 34-35, Wright also discloses wherein the step of including a message comprises recording a customized message applied with the device to a message region of the document by capturing associated interaction data transmitted during movement of the device (col 6, line 53 – col 7, line 5).

With regard to claims 6 and 21, Wright also discloses wherein the step of sending the card includes selecting the recipient address, using the device, from an address list provided with user-interactive elements (col 11, lines 42-57).

With regard to claims 7 and 22, Wright also discloses wherein the step of sending the card includes writing the recipient address in an address field of a form

using the sensing device and capturing the writing by recording the associated interaction data (col 11, lines 42-57).

With regard to claims 8 and 23, Wright also discloses wherein the recipient address corresponds to a printer address and the card is delivered by printing at that address (col 7, lines 36).

With regard to claims 9 and 24, Wright also discloses wherein the recipient address corresponds to an electronic mail address and an image of the card is delivered to that address (col 7, lines 6-11).

With regard to claims 10 and 25, Wright also discloses wherein the recipient address corresponds to a street address and the card is sent to a proximate mail service for printing and delivery to the street address (col 7, lines 6-41).

With regard to claims 11 and 26, Wright also discloses wherein a preview of the card and message is provided in a further document for review prior to sending (col 6, lines 53-55).

With regard to claims 12 and 27, Wright also discloses wherein the document includes coded data indicative of an identity of the document and of the at least one interactive element, and wherein the method includes receiving, in the computer system, indicating data from the sensing device regarding the identity of the document and a position of the sensing device relative to the document in order to identify the document and determine when the sensing device is used to interact with the element (col 5, lines 4-35).

With regard to claims 13 and 28, Wright also discloses including receiving, in the

computer system, movement data regarding movement of the sensing device relative to the document (col 5, lines 4-45).

With regard to claims 14 and 29, Wright also discloses including the sensing device sensing its movement relative to the document using the coded data, and identifying the request in the computer system from the movement being at least partially within a zone associated with the interactive element (col 5, lines 4-45).

With regard to claims 15, 30 and 39, Wright also discloses which includes printing the coded data to be substantially invisible in the visible spectrum (col 5, lines 4-45).

With regard to claim 16, Wright discloses a method of enabling selection and delivery of a greeting card (col 1, lines 6-11), including: providing a printed document with details of a selection of available greeting cards (col 4, lines 18-24; col 5, lines 51-57), the printed document having at least one user-interactive element with which a user interacts to select a card using a sensing device adapted to transmit interaction data to a computer system (col 4, line 17 – col 7, line 11); indicating selection of a card using the sensing device (col 6, lines 43-53); including a message using the sensing device (col 6, line 53 – col 7, line 5); and sending the card to a recipient address via the computer system (col 7, lines 6-11).

Wright does not teach using coded data thereon, at least some of the coded data representing at least one user-interactive element with which a user interacts to sense the coded data.

Cass discloses a process that includes using coded data thereon, at least some of the coded data representing at least one user-interactive element with which a user interacts to sense the coded data (col 2, lines 29-67; col 11, lines 15-26).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wright to include using coded data thereon, at least some of the coded data representing at least one user-interactive element with which a user interacts to sense the coded data as taught by Cass. It would have been obvious of one of ordinary skill in at the art at the time of the invention to have modified Wright by the teaching of Cass to specially coded information, such as a pattern of data glyphs or a bar code, can be included in the form itself to indicate the layout of the blank fields in the form. The computer can be programmed in this case to seek the coded information at a predesignated location within the received image, and to use the coded information together with additional (stored or preprogrammed) information to identify what kind of form has been sent and to determine what is to be done in response to the boxes checked by the user as taught by Cass col 2, lines 29-67.

With regard to claim 33, Wright also discloses wherein the message is a written message and the computer system is adapted to digitally capture the written message by recording associated interaction data transmitted by the sensing device (col 6, line 53 – col 7, line 5).

With regard to claim 36, Wright also discloses wherein the sensing device includes a marking nip (col 6, lines 62-64).



With regard 37, Wright also discloses wherein the document is printed on a surface of a surface-defining structure and wherein the printer prints the document on demand (col 7, lines 31-36).

With regard to claim 38, Wright also discloses wherein the printer is arranged to print the coded data at the same time as printing the document on a surface-defining structure (col 7, lines 31-36).

With regard to claim 40, Wright also discloses including a database for keeping a retrievable record of each document generated, each document being retrievable by using its identity, as included in its coded data (col 3, lines 58-61; col 5, lines 10-57).

***Response to Arguments***

7. Applicant's arguments, see Amendment B, filed 4/26/04, with respect to the rejection(s) of claim(s) 1-40 under 35 USC 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Cass (US 5,692,073).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler Lamb whose telephone number is 703 - 308-8823. The examiner can normally be reached on M-TH (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-308-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6036 for regular communications and 703-872-9314 for After Final communications.

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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 872-9314

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two

2121 Crystal Drive

Arlington, VA.

Sixth Floor (Receptionist)

Twyler Lamb



June 26, 2004